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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,597	10/25/2001	Mark Krichever	646	6070
7590	03/03/2004		EXAMINER	
ALAN ISRAEL KIRCHSTEIN, OTTINGER ISREAL & SCHIFFMILLER 489 FIFTH AVENUE NEW YORK, NY 10017			LEE, DIANE I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/040,597	KRICHEVER ET AL.	
	Examiner D. I. Lee	Art Unit 2876	<i>PLW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3, 12, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 12, 15 and 16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 04 September 2003. Claim 1 has been amended; claims 4-10, 13-14, and 17-20 have been canceled; and no claims have been newly added. Currently, claims 1-3, 12, and 15-16 are pending in this application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 September 2003 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner

to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan et al. [US 6,098,877-referred as Barkan] in view of Kobayashi et al. [US 4,129,369-referred as Kobayashi] and Fujibayashi [US 5,980,045-previously cited by the examiner].

Re claim 1: Barkan discloses a portable instrument such as a scanner for electro-optically reading coded indicia over an extended range of working distances, comprising:

a) a housing having a size and a shape configured to be held in a user's hand during reading (see figure 14b);

b) a plurality of electrical and optical components supported by the housing, for directing a light beam along an optical path (i.e., path define by the direction of the light beam) toward the indicia for reflection therefrom and for detecting light reflected from the indicia over a field of view, one of the components (the optics systems 172a, 172b) being movable between first and second positions (i.e., in and out of the optical path) in which said one of the components is operative for optically modifying at least one of the light beam and the reflected light at first and second optical areas, respectively (see figure 15 and 16b), another of the components being an actuatable scanner 168, 178 for scanning at least one of the light beam and the field of view (see col. 15, lines 20+); and

c) a manual actuator mounted on the housing for actuation by the user, and being operative for manually moving said one of the components between the first and second positions to selectively optically modify said at least one of the light beam and the reflected light at the first and second optical areas, respectively, i.e., the trigger 182 is a two position trigger having a first switching position and a second switching position, such that the first switching position of the trigger 182 is used for moving one of the components (the optics systems 172a, 172b) between the first and second positions to selectively and optically modify said at least one of the light beam and the reflected light at the first and second

optical areas (see col. 15, lines 12-20), the trigger 182 is also used for manually actuating the scanner to initiate reading by positioning the trigger 182 in a second switching position (see col. 14, lines 47+; col. 15, lines 8+; figure 14-16).

d) an element (a moving mechanism including a lens drive 174 that physically engaged with and compressed by movement of the optical component, e.g., the lens 172a, 172b, the physically moving operation of the moving mechanism is not specifically shown, to one of the position, i.e., the moving operation of the moving mechanism positioning the lens to one of the position, such as near range), the element being operative for urging and restoring the one of the optical components (the lens 172a, 172b) to the other of the positions (i.e., far range) upon release of the actuator by the user (i.e., the position trigger 182 having a plurality of positions or depressed position, see col. 15, lines 1+).

Although Barkan does not show the scanner having such configuration having all the element in one embodiment, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the optical elements shown in other embodiment as a possible implement components (e.g., dual mode optical) in the such configuration shown in figure 14b in order to extend the capability of the scanner and to provide an additional benefit such as a hand-held scanner with a dual mode configuration.

Barkan teaches that the actuator is a trigger manually actuatable and mechanically connected the one of the components for and being operative for moving the one of the components between the first and second position, however, Barkan does not explicitly teach the actuator is a slide switch slidable along the housing for manually, directly moving the one of the component.

Kobayashi discloses a camera having a close-up lens 2 that may be selectively movable into and out of the optical path to selectively provide photographic condition. Wherein the close-up lens 2 is supported by the lens frame 2b. The lens frame having a switching means (a manual actuator 2a which mounted on the camera body A) for slidably move the close-up lens 2 into and out of the optical path,

i.e., the actuator 2a mounted on the camera housing for movement by the user and mechanically and operatively connected to the lens 2 for manually and directly moving the lens between the first and second position by the selector 2a (see col. 2, lines 54+ and figures 11).

In view of Kobayashi's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to substitute the manual switching means in the actuator mechanism of Barkan in order to simplified the switching structure and to reduce the manufacturing costs of the portable instrument.

Although Barkan as modified by Kobayashi teaches the actuator is a trigger manually and directly moving the one of the components in and out of the optical path between the first and second position, Barkan as modified by Kobayashi does not teach the optical component moving along the optical path between the first and second position.

Fujibayashi discloses an image forming apparatus having a light source and a field lens 5 capable of moving on the optical path (see figures 1-2). The field lens 5 having a positive refracting power capable of moving on the optical axis by an optical moving means (i.e., a motor 78 and a position control circuit 16) to provide a high magnification (see col. 4, lines 40+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a lens capable of moving on the optical axis, as taught by Fujibayashi, in the optical instrument of Barkan as modified by Kobayashi in order to for a variable magnification of the light beam. Such modification would have provided Barkan as modified by Kobayashi with an optical instrument having a variable size of the imaging area (i.e., the greater magnification would provide greater image working area and the reduced magnification would provide smaller image working area). Accordingly, it would have been an obvious modification as taught by Barkan as modified by Kobayashi.

Re claims 2 and 3: wherein another of the components is a light source for emitting the light beam, and wherein said one of the components includes a focusing lens for focusing the light beam at the

first and second optical areas located in the range outside the housing, the first and second optical areas being foci located at different working distances relative to the housing (see col. 14, lines 66+ and figure 16b);

Re claim 12: wherein reader further includes another of the components is a light detector 405 for detecting the reflected light and generating an electrical signal indicative thereof, a processor for processing the electrical signal into a processed signal during reading, component suitable to carry a batch data communication which obviously include a memory for storing the processed signal and for downloading the data, and wherein said one of the components includes a focusing lens 172a, 172b for focusing at the detector the reflected light from the indicia respectively located at the first and second optical areas in the range outside the housing, the first and second optical areas being located at different working distances relative to the housing (see col. 14, lines 66+ and figure 16b);

6. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan as modified by Kobayashi and Fujibayashi as applied to claim 1 above, and further in view of Plesko [US 5,506,394].** The teachings of Barkan as modified by Kobayashi have been discussed above.

Barkan as modified by Kobayashi and Fujibayashi does not teach the reader having a pointing mode.

Plesko discloses a stylus bar code scanner (see figures 1-4) having a narrow, elongated housing 1 extending along an axis between opposite end regions, and having a size and shape configured to be held in a user's hand during scanning process which includes an aiming (pointing) mode and a reading mode, aiming the target during the pointing mode for moving the light in a pattern over the target and creating a visual display on a target, i.e., generating the laser light beam as a visible beam (see col. 16, lines 46-48 and col. 18, lines 1+).

It would have been an obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporating the pointing mode capability in order to point/highlight a code/object in order to accurately identify or target the object position to improve the scanning.

7. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan as modified by Kobayashi and Fujibayashi as applied to claim 1 above, and further in view of Huang [US 5,617,304].** Teachings of Barkan as modified by Kobayashi and Fujibayashi have been discussed above.

Barkan as modified by Kobayashi and Fujibayashi does not disclose the other end of the housing of portable instrument implementing a marker which facing a surface to be marked.

Huang discloses a portable, dual-use device for marking surface and an optical instrument. The dual-use device is supported by the housing (see figures 1-4) having a combination of laser pointer at one end and a marking implement such as a ballpoint pen unit at the opposite end regions of the housing capable of marking on paper (see figure 1). The housing bounds an interior in which the internal component 22 is accommodated. The housing as separable portions 10, 20, which upon separation, enable access to the interior and an exterior clip 25 for clipping the housing to a part of the user's clothing (see col. 1, line 59-col. 2, line 43 and figure 1).

In view of Huang's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to implement a notoriously well known dual-use instrument as taught by Huang in the teachings of Barkan as modified by Kobayashi and Fujibayashi by incorporating a conventional marking means and the housing structure of a dual-use instrument to the pen-shaped bar code reader of Barkan as modified by Kobayashi and Fujibayashi in order to provide the user with a pen shaped bar code reader that can also be held by a single hand of a user during both marking and data collection. Official Notice is taken that combining an optical instrument with a conventional marker so as

to obtain an optical instrument and a marker in a compact and lightweight hand-held instrument that can also be held by a single hand of a user is old and well known in the optical art. See *In Re Malcolm* 1942 C.D.589:543 O.G. 440. Accordingly, such modification would have been an obvious extension taught by Barkan as modified by Kobayashi for a more versatile system and therefore, an obvious expedient.

Response to Arguments

8. Applicant's arguments filed 04 September 2003 have been fully considered but they are not persuasive.
9. Applicant indicated that the prior art does not show or suggest the compressibility and restoring function of the element (see page 5, lines 2+). The examiner respectfully disagrees. Barkan teaches an element, such as a mechanism including a lens drive 174 that physically engaged with and compressed by movement of the optical component, such as the lens 172a, 172b (the physical moving mechanism is not specifically shown) to one of the position (i.e., the moving mechanism physically positioning the lens to one of the position, such as near range), the lens drive being operative for urging and restoring the one of the optical components (the lens 172a, 172b) to the other of the positions (i.e., far range) upon release of the actuator by the user (i.e., the position trigger 182 having a plurality of positions or depressed position that clearly produces urging and restoring functions see col. 15, lines 1+).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for the organization where

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this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.